

9/02/04

3739
Jfw



PATENT

Attorney Docket No. 0320-0018 (formerly HOOV 118)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael D. Hooven, et al.

Serial No.: 10/015,862

Filed: December 12, 2001

Group Art No.: 3739

Examiner: Rosiland S. Rollins

For: TRANSMURAL ABLATION DEVICE
WITH SPRING LOADED JAWS

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" Mailing Label No.: EV 459450178 US

Date of Deposit September 1, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office Box Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

NAME Renée C. Barthel

SIGNATURE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION OF JUNE 16, 2004

Claims 9-23 are pending in this application. Claim 9 is the only independent claim.

In the Office Action dated June 16, 2004, claims 9-23 were rejected under 35 U.S.C. 103(a) as being obvious in view of the combination of U.S. Patent Application Publication 2003/0073991 to Francischelli (Francischelli) and U.S. Patent No. 6,679,882 to Kornerup (Kornerup). Additionally, claims 9-23 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7 and 11 of the

U.S. Patent No. 6,517,536 to Hooven et al. in view of Francischelli and Kornerup.

In response to the Office Action, it is respectfully requested that Francischelli and Kornerup are not properly combinable to render claim 9 obvious. The Office Action recognizes that the structure in Francischelli does not teach or suggest "at least one of the jaws being biased so as to urge the jaws toward the clamped position with a force that increases as the separation of the jaws increases", as recited in claim 9. The structure in Francischelli requires the jaws of the device to be urged to the clamped position under the force of magnetic attraction which decreases as the jaws separate, in contrast to the claim 9. Thus, Francischelli alone fails to teach or suggest the subject matter of claim 9.

The current Office Action, however, relies upon Kornerup in combination with Francischelli to teach the subject matter of claim 9. Kornerup is relied upon specifically at column 3, lines 33-45, which discloses, "an adjustable spring loading means for applying a specific or an adjustable spring load for closing the first and second jaws relative to one another" (column 3, lines 36-38). However, this disclosure cannot be read in a vacuum, but rather, must be read in the context of cited references.

It is submitted that the cited references have contrary teachings or suggestions which would not be combinable in the absence of the disclosure or motivation provided by the current

application. The Federal Circuit has made clear that the current application cannot be used as a blueprint to pick and choose among the prior art references. Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361, 1371-72 (Fed. Cir., 2000), reh. denied, 2000 U.S. App. Lexis 34050, cert. denied, 532 U.S. 974 (2001). The Federal Circuit stated in Ecolochem that:

"the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2D (BNA) at 1617. 'Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.'" Id. (emphasis added).

In Ecolochem, the Federal Circuit further emphasized that "[w]hen a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2D (BNA) 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2D (BNA) 1276, 1278 (Fed. Cir. 1987))".

It is respectfully submitted that in this there is no teaching, suggestion or motivation to make the alleged combination without improperly relying on the hindsight provided by applicants' disclosure. Francischelli and Kornerup teach very different ways for providing a clamping force. Francischelli teaches a jaw structure which uses a magnetically attractive force to bring the jaws together. The magnetic force decreases as the distance

between the jaw increases. Unlike Francischelli, any increase of distance between Kornerup's jaws increases the spring force which normally biases the jaws to a closed position. There is no motivation or suggestion in the cited references as to how or why one or ordinary skill would take features from Kornerup and install them in Francischelli, or vice versa, when they rely upon fundamentally different principles of operation. It is only by impermissibly relying on applicants' disclosure that the combination of these references makes sense. The hindsight provided by applicants' disclosure cannot be used as the basis for the combination of these references.

It further would not be obvious to combine these references because of the significant differences in their described structure. In Kornerup, the structure of the jaws 6 and 7 is comprised entirely of non-insulated conductive wires 8 and 9. The jaws 6 and 7 move between the opened and closed positions by the inherent spring force characteristics of the wires 8 and 9 themselves. The wires 8 and 9 are "bent such that a spring force is achieved tending to force the jaws 6 and 7 away from one another" (column 7, lines 1-7). The wires 8 and 9 further include curved camming portions 10 and 11 which cooperate to move the jaws to a clamped position, as shown in Figure 3 (column 7, lines 18-25). A coil spring 19 normally biases the wires 8 and 9 in a proximal direction so that the jaws are located in a clamped

position (column 7, lines 25-37). Therefore, the wires 8 and 9 have a specific shape or configuration which is essential to the proper functioning of the jaws.

In contrast, Francischelli teaches a significantly different jaw structure which is simply not combinable with Kornerup. Francischelli's described ablation hemostat device contains a pair of magnets or a series of magnets situated along the insulated jaws. The magnets are arranged so that the attractive force between the magnets will cause the jaws to be attracted to each other along the jaws length. The magnets "assist in compressing the jaws of the hemostat along their length, assuring good contact with the tissue along the length of the jaws" (paragraph [0019], emphasis added).

It is respectfully submitted that there is no motivation to make the alleged combination of Kornerup and Francischelli in the absence of applicants' disclosure. There is no teaching or suggestion in either reference to make such combination. Francischelli, unlike Kornerup, teaches that the clamping or compressing of tissue between the jaws is provided from magnetic attraction and not from a particular wire shape or configuration. Further, Francischelli teaches and suggests that the magnets alone provide sufficient clamping force to contact the tissue so that there is no need for Kornerup's spring coil to bias the jaws closed.

In fact, the references arguably teach away from the alleged combination. Kornerup effectively teaches away from any jaw structure which is not entirely comprised of an uninsulated wire having a specific configuration. This configuration is critical to proper functioning of Kornerup's jaw structure. Kornerup offers no teaching or suggestion as to how the jaw structure would properly function for devices having other jaw configurations such as disclosed in Francischelli. Indeed, Kornerup was filed before Francischelli. Francischelli thus represents an improvement over the teachings of Kornerup which avoids the requirement for a specific jaw configuration.

For these reasons, it is respectfully submitted that amended claim 9 would not be obvious, and, accordingly, this claim is respectfully believed to be allowable. The dependent claims 13-23, which depend directly or indirectly from amended claim 9, contain all the features of claim 9 and should be allowed for the reasons set forth above. Reexamination and allowance are respectfully requested.

Claims 9-23 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7 and 11 of U.S. Patent 6,517,536 in view of the combination of Francischelli and Kornerup. For the reasons set forth above, the alleged combination does not suggest a device as

in amended claim 9. Withdrawal of this rejection is respectfully requested.

Respectfully submitted,

Date: September 1, 2004

By:



Renée C. Barthel
Registration No. 48,356
Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd.
200 West Adams St., Suite 2850
Chicago, IL 60606
Telephone: (312) 236-8500

Attorneys for Applicants